

### **REMARKS**

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-30 were pending in the application, of which Claims 1, 6, and 25 are independent. In the Office Action dated March 28, 2006, Claim 18 was objected to, Claims 1-30 were rejected under 35 U.S.C. §101, Claims 1-4, 6-7, 10-11, 15-23, 25, 29, and 30 were rejected under 35 U.S.C. §112, Claims 1-5 were rejected under 35 U.S.C. § 102(e), and Claims 6-30 were rejected under 35 U.S.C. §103(a). Following this response, Claims 1-7 and 9-30 remain in this application, Claim 8 being canceled without prejudice or disclaimer. Applicant hereby addresses the Examiner's rejections in turn.

#### **I. Claim Objections**

In the Office Action dated March 28, 2006, the Examiner objected to Claim 18 as containing various informalities. Claim 18 has been amended to address these informalities and does not narrow the claimed subject matter. Applicant respectfully submits that the amendment overcomes this objection and adds no new matter.

#### **II. Claim Rejections Under 35 U.S.C. §112, Second paragraph**

In the Office Action, the Examiner rejected Claims 1-4, 6, 7, 10, 11, 15-23, 25, 29, and 30 under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 1-4, 6, 7, 10, 11, 15-23, 25, 29, and 30 have been amended. Applicants respectfully submit that the amendments overcome this

rejection and adds no new matter. Accordingly, Applicant respectfully request withdrawal of this rejection of Claims 1-4, 6, 7, 10, 11, 15-23, 25, 29, and 30.

### III. Claim Rejections Under 35 U.S.C. §101

In the Office Action, the Examiner rejected Claims 1-30 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 1, 6, and 25 have been amended and Applicant respectfully submits that the amendments overcome this rejection and add no new matter.

### IV. Claim Rejections Under 35 U.S.C. §102(e)

In the Office Action, the Examiner rejected Claims 1-5 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,785,418 ("*Williamson*"). Claim 1 has been amended, and Applicant respectfully submits that the amendment overcome this rejection and adds no new matter. Support for this amendment may be found in the specification at least on page 3, lines 16-21.

Amended Claim 1 is patentably distinguishable over the cited art for, at least for the reason that it recites, for example, "accepting a search query, where the search query comprises a search query word and a list of electronic documents."

In contrast, *Williamson* at least does not disclose the aforementioned recitation. For example, *Williamson* merely discloses that alternate information, including probability information, is used to determine whether an ink word sufficiently matches a search word to be matched. (See col. 8, lines 61-67.) For example, an ink processor 54, in *Williamson*, includes code that serves as a search mechanism

78, that takes an enter term 80 and evaluates it against information in a text buffer. (See col. 9, lines 1-5.) In *Williamson*, the ink word in a document for which the search mechanism 78 is searching can be considered as recognized or sent to a recognizer when encountered during a search. (See col. 9, lines 9-14.) In *Williamson*, a user searches a single document. Accordingly, because *Williamson* discloses searching a single document, *Williamson* does not disclose searching multiple documents or a list of documents.

In short, *Williamson* does not anticipate the claimed invention because *Williamson* at least does not disclose "accepting a search query, where the search query comprises a search query word and a list of electronic documents," as recited by amended Claim 1. Accordingly, independent Claim 1 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claim 1.

Dependent Claims 2-5 are also allowable at least for the reasons described above regarding independent Claim 1, and by virtue of their dependency upon independent Claim 1. Accordingly Applicants respectfully requests withdrawal of this rejection of dependent Claims 2-5.

#### V. Claim Rejections Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected Claims 6-9, 12-15, and 25-29 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,859,800 ("*Roche*") in view of U.S. Patent No. 4,832,474 ("*Lopresti*"). Claims 6 and 25 have been amended, and Applicant respectfully submits that the amendment overcome this

rejection and add no new matter. Support for these amendments may be found in the specification at least on page 21, lines 15-23.

Amended Claim 1 is patentably distinguishable over the cited art for, at least for the reason that it recites, for example, "determining when the match to the first query word before the boolean operator and the match to the first query word after the boolean operator satisfy a spatial relationship, wherein the spatial relationship is satisfied when the match to the first query word before the boolean operator and the match to the first query word after the boolean operator occur within a portion of the document currently displayed in a viewable area." Amended Claim 25 includes a similar recitation.

As stated by the Examiner in rejecting dependent Claim 10, *Roche* in view of *Lopresti* does not teach, suggest, or disclose a spatial relationship occurring within an electronic document. (See Office Action page 13, lines 4-6.) Therefore, since *Roche* in view of *Lopresti* does not teach, suggest, or disclose a spatial relationship occurring within an electronic document, they cannot teach, suggest, or disclose spatial relationships being satisfied when occurring within a portion of the document currently displayed in a viewable area.

Combining *Roche* with *Lopresti* would not have led to the claimed invention because *Roche* and *Lopresti*, either individually or in any reasonable combination, at least does not disclose determining when the match to the first query word before the boolean operator and the match to the first query word after the boolean operator satisfy a spatial relationship. Furthermore, *Roche* and *Lopresti* does not disclose wherein the spatial relationship is satisfied when the match to the first query word

before the boolean operator and the match to the first query word after the boolean operator occur within a portion of the document currently displayed in a viewable area, as recited by amended Claim 6. Amended Claim 25 includes a similar recitation. Accordingly, independent Claims 6 and 25 each patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claims 6 and 25.

Dependent Claims 7, 9-15, and 16-30 are also allowable at least for the reasons described above regarding independent Claims 6 and 25, and by virtue of their respective dependencies upon independent Claims 6 and 25. Accordingly Applicant respectfully requests withdrawal of this rejection of dependent Claims 7, 9-15, and 16-30.

#### VI. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims.

Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Action.


Please grant any extensions of time required to enter this response and charge any additional required fees to deposit account 13-2725.

Respectfully submitted,  
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